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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/798,282      | 03/12/2004  | Yoshihisa Usami      | Q79893              | 6447             |

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT PAPER NUMBER

1774

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/798,282

Applicant(s)

USAMI ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-19 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's response filed on 09/06/2005 has been fully considered. The Claim Objection and the Double Patenting Rejection have been withdrawn in view of Applicant's amendment.
2. Claims 1-7 and 9-17 are amended, claim 8 is canceled, claims 18-24 are added, and thus claims 1-7 and 9-24 are pending.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 9-19 and 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Koike et al. (US 6,777,039 B2).
5. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Koike discloses an ink jet recording sheet comprising a support and a colorant-receiving layer on the support (abstract). The colorant-receiving layer formed by: applying a first coating liquid having polyvinyl alcohol, a high boiling point organic solvent such as diethyleneglycol monobutyl ether (DEGMBE) and triethyleneglycol monobutyl ether and at least a nonionic surfactant diethyleneglycol monoethyl ether, to a dispersion that includes silica to form a coat layer; adding, to the coat layer formed by the application of the first coating liquid, a second coating liquid, which includes a cross-linking agent such as boron compound and a mordant either at the same time as the application of the first coating liquid or during drying of the coat layer of the first coating liquid but before the coat layer shows a decreasing rate of drying (col. 5, line 9; col. 9, line 13; col. 10, line 3; col. 10, line 43). The support comprises polyethylene-coated paper (col. 20, line 12). The coated polyethylene is equivalent to the claimed undercoat layer. Koike teaches incorporating titanium oxide into the polyethylene layer to improve the degree of non-transparency and whiteness (col. 20, line 17); therefore, with respect to the diffusion reflectance of the undercoat layer and the surface gloss of the recording sheet "it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Koike reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. The process

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by which the colorant-receiving layer is formed is not dispositive of the issue of the patentability of the instant article claims.

With respect to claims 18 and 19, see col. 6, line 53.

### ***Response to Arguments***

6. Applicant's argument is based on that the invention of Koike is directed to only an inkjet recording sheet. This argument is not persuasive because Koike teaches the use of the ink jet recording sheet on a variety of recording media (col. 1, lines 19-25). Thus claims 1-7 and 9-17 stand rejected and claims 18, 19 and 21-24 are included in the rejection.

### ***Allowable Subject Matter***

i. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art neither teaches nor suggests the claimed thickness of the substrate.

### ***Conclusion***

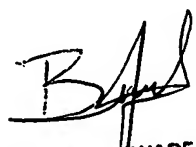
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.S.  
November 28, 2005.

  
BETELHEM SHEWAREGED  
PRIMARY EXAMINER